

REMARKS

The Office Action mailed October 4, 2007, has been received and reviewed. Claims 1 through 21 are currently pending in the application. Claims 1 through 21 stand rejected. Applicants have amended claims 1, 7, and 12, have cancelled claim 14, and respectfully request reconsideration of the application as amended herein.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on U.S. Patent No. 5,358,851 to Peck in View of U.S. Patent No. 6,610,908 to Chapple

Claims 1 through 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Peck (U.S. Patent No. 5,358,851) in view of Chapple (U.S. Patent No. 6,610,908). Applicants respectfully traverse this rejection, as hereinafter set forth.

To establish a *prima facie* case of obviousness the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974); *see also* MPEP § 2143.03. Additionally, there must be “a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742, 167 L.Ed.2d 705, 75 USLW 4289, 82 U.S.P.Q.2d 1385 (2007). Finally, to establish a *prima facie* case of obviousness there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Furthermore, the reason that would have prompted the combination and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based on the Applicant’s disclosure. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); MPEP § 2144. Underlying the obvious determination is the fact that statutorily prohibited hindsight cannot be used. *KSR*, 127 S.Ct. at 1742; *DyStar*, 464 F.3d at 1367.

Independent claim 1 has been amended to recite a method for assaying a chemical comprising: providing an extraction solution for dissolving a chemical of a solid, organic sample and a predetermined amount of an internal standard in a container; collecting a sample at a first location; placing the solid, organic sample in the container; transporting the container including

the sample from the first location to a chemical testing facility; quantitatively measuring an amount of the chemical in the extraction solution at the chemical testing facility; and comparing the amount of internal standard present in the container at the chemical testing facility with the amount of internal standard placed in the container at the first location to obtain a calibration ratio.

Independent claim 12 has been amended to recite a method for analyzing a sprout inhibitor on a tuber comprising: collecting a tuber sample from the tuber at a first location; depositing the tuber sample into a container including an extraction solution; transporting the container including the tuber sample to a chemical testing facility; assaying the sprout inhibitor in the extraction solution at the chemical testing facility; placing a predetermined amount of an internal standard in the extraction solution; quantifying an amount of the internal standard in the extraction solution; and comparing the quantified amount of the internal standard in the extraction solution in the container at the chemical testing facility with the predetermined amount of the internal standard placed in the extraction solution deposited in the container at the first location.

Peck does not teach or suggest collecting a solid, organic sample (as required by claim 1) or a tuber sample (as required by claim 12). Peck also does not teach or suggest transporting a container that includes the sample, extract solution, and internal standard from a first location to a chemical testing facility. Finally, as acknowledged by the Examiner, Peck does not teach or suggest use of an internal standard. Chapple is relied upon as disclosing a method of analyzing a lignin monomer sample and providing a glass tube comprising an extraction solution and an internal standard. However, Chapple does not overcome the previously described deficiencies of Peck. Additionally, Chapple teaches a method of using an internal standard that accounts for analyte lost during the extraction process or gas chromatography steps. In contrast, claims 1 and 12 (and all of the claims depending therefrom) compare the amount of internal standard present in the container at the chemical testing facility with the amount of internal standard placed in the container at the first location to obtain a calibration ratio. Therefore, the use of internal standard is entirely different, as the present invention uses the internal standard to determine loss of chemical from the sample (tuber) during transport from the field to a chemical testing facility.

The nonobviousness of independent claims 1 and 12 precludes a rejection of claims 2-11, 13, and 15-21 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, the Applicants request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to claims 1-13 and 15-21.

ENTRY OF AMENDMENTS

The amendments to claims 1, 7, and 12 above should be entered by the Examiner because the amendments are supported by the as-filed specification and drawings and do not add any new matter to the application. Further, the amendments do not raise new issues or require a further search.

CONCLUSION

Claims 1-13 and 15-21 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, the Examiner is respectfully invited to contact Applicants' undersigned attorney.

Respectfully submitted,



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Date: February 4, 2008
ERC/dn:tlp
Document in ProLaw